REMARKS

In the Office Action, the Examiner rejected claims 1-11, 16-29, and 34-49 under 35

U.S.C. § 102(e) as anticipated by Rodriguez et al. (US Patent Publication No. 2002/0067806);

and rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Rodriguez

et al. in view of McAllister et al. (U.S. Patent No. 6,442,242). The Examiner objected to claims

14, 15, 32, and 33 as dependent upon a rejected base claim, but would be allowable if rewritten

in independent form to include all of the features of the base claim and any intervening claims.

By this Amendment, Applicants cancel claim 8 and amend claims 1, 9-15, 19, 37, 39, 41,

42, and 48 to improve form. Applicants appreciate the Examiner's identification of allowable

subject matter. Applicants traverse, however, the Examiner's rejections under 35 U.S.C. §§ 102

and 103 with regard to the amended claims. Claims 1-7 and 9-49 are pending.

At pages 2-12 of the Office Action, the Examiner rejected pending claims 1-7, 9-11, 16-

29, and 34-49 under 35 U.S.C. § 102(e) as allegedly anticipated by Rodriguez et al. Applicants

traverse the rejection with regard to the amended claims.

Rodriguez et al. discloses a phone answering system that notifies a user of urgent phone

messages (Abstract). When a telephone or text message is received by the phone answering

system, a priority is determined for the message (Abstract). If the message is identified as urgent,

the system repeatedly dials the subscriber's phone in order to notify the subscriber of the urgent

message (Abstract).

By contrast, the present invention recited in amended claim 1, for example, includes a

combination of features of a method for delivering a message to a receiving party. The method

includes receiving a message intended for the receiving party, determining whether the message

should be delivered to the receiving party, and translating the message from a source format to message text. The method further includes converting the message text to an audible message when the message should be delivered to the receiving party, initiating a telephony call to the receiving party, and delivering the audible message to the receiving party during the telephony call.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either expressly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. Rodriguez et al. does not disclose or suggest each of the features recited in amended claim 1. For example, Rodriguez et al. does not disclose or suggest translating a message from a source format to message text.

When rejecting a similar feature in canceled claim 8, the Examiner alleged that Rodriguez et al. "teaches inherently translating the message from a caller's analog voice to digital form" and cited paragraphs 0024 and 0025 of Rodriguez et al. for support (Office Action, page 4). Applicants submit that the Examiner is misinterpreting the disclosure of Rodriguez et al.

At paragraphs 0024 and 0025, Rodriguez et al. discloses:

[0024] FIG. 1a shows a system diagram of a caller leaving an urgent message. Caller 100 dials a phone number corresponding with unavailable receiver 120. The phone signal travels through telephone network 110 in order to ring the phone corresponding with unavailable receiver 120. When unavailable receiver 120 does not answer, telephone answering system 140 answers and prompts caller 100 for a message and a priority. Telephone network 110 may include a mobile telephone network, the public switched telephone network, or a private telephone exchange within an organization.

[0025] While telephone answering system 140 is shown attached to telephone network 110, in some embodiments, such as a stand alone answering machine, telephone answering system 140 is included in or attached to the receiving telephone. In addition, as used herein, a message stored on an answering system may be any type of message that can be left on the particular answering system. Traditional answering systems record a caller's analog voice and store the caller's vocal message in either a digital or analog

form. Some answering systems also receive digital text messages left by a caller using email or a device, such as a touch-tone phone, an alpha-numeric pager, or a personal digital assistant (PDA).

Nowhere in these paragraphs, or elsewhere, does Rodriguez et al. disclose or suggest translating a message from a source form to message text, as recited in amended claim 1. Instead, Rodriguez et al. discloses storing a caller's vocal message in either digital or analog form (paragraph 0025), which means storing the message as either a digitized voice message or analog voice message. This does not imply, as the Examiner appears to be alleging, that Rodriguez et al. discloses translating the caller's vocal message to a digital text message. Nowhere does Rodriguez et al. disclose or suggest such a translation.

Also, Rodriguez et al. does not disclose converting the message text to an audible message when the message should be delivered to the receiving party, as recited in amended claim 1. Rodriguez et al. discloses that the answering system can receive analog voice messages, as well as digital text messages (paragraph 0025). Rodriguez et al. also discloses that a digital text message may be converted to an audible message using speech synthesis software (paragraph 0028). The digital text message described by Rodriguez et al. is not, however, message text that was generated by translating a message from a source format, as recited in amended claim 1.

For at least these reasons, Applicants submit that claim 1 is not anticipated by Rodriguez et al. Claims 2-7, 9-11, and 16-18 depend from claim 1 and are, therefore, not anticipated by Rodriguez et al. for reasons similar to those given with regard to claim 1.

Amended independent claim 19 recites a combination of features of a system for presenting a message to a receiving party. The system includes means for obtaining a user profile corresponding to the receiving party, means for obtaining a message intended for the

receiving party, and means for testing the message against the user profile, where the user profile specifies at least one of a date and time of message arrival. The system also includes means for converting the message to an audible message when the message passes the test, means for initiating a telephony call to the receiving party, and means for presenting the audible message to the receiving party during the telephony call.

Rodriguez et al. does not disclose or suggest each of the features recited in amended claim 19. For example, Rodriguez et al. does not disclose or suggest means for testing a message against a user profile, where the user profile specifies at least one of a date and time of message arrival. Instead, the telephone answering system in Rodriguez et al. stores and delivers messages based on message priority (paragraphs 0030-0031), not based on when (date and/or time) the messages arrived, as recited in amended claim 19.

For at least the foregoing reasons, Applicants submit that claim 19 is not anticipated by Rodriguez et al.

Independent claim 20 recites a combination of features of a message delivery system that includes a message receiver and a call processor. The message receiver is configured to obtain a message intended for a receiving party, determine whether the message should be delivered to the receiving party, and convert the message from a source format to a target format when the message should be delivered to the receiving party. The call processor is configured to convert the message from the target format to an audible format, initiate a telephony call to the receiving party, and deliver the message in the audible format to the receiving party during the telephony call.

Rodriguez et al. does not disclose or suggest each of the features recited in claim 20. For example, Rodriguez et al. does not disclose a message receiver that converts a message from a source format to a target format when the message should be delivered to the receiving party and a call processor that converts the message from the target format to an audible format.

The Examiner alleged that Rodriguez et al. discloses these features (Office Action, page 7). In particular, the Examiner alleged that the "caller's vocal message" reads on the claimed source format, "digital form" and "digital text message" read on the claimed target format, and "audible message" reads on the claimed audible format (Office Action, page 7). Applicants disagree with the Examiner's reasoning. The Examiner has identified a message in a voice format and a message in a text format as the claimed message in the target format. In particular, the Examiner identified "digital form" from paragraph 0025 and "digital text message" from paragraph 0028 of Rodriguez et al. as allegedly being equivalent to the claimed target format.

At paragraph 0025, Rodriguez et al. discloses that a caller's vocal message can be stored in either a digital or analog form. In this case, the digital form corresponds to a digitized voice message. Rodriguez et al. does not disclose converting the digitized voice message to an audible format (probably because it is already in an audible format).

At paragraph 0028, Rodriguez et al. discloses that a digital text message can be converted to an audible message. In this case, the digital text message corresponds to a text message received by the answering system. Rodriguez et al. does not disclose that the digital text message was generated by converting a message from a source format.

Because <u>Rodriguez et al.</u> does not disclose converting a message from a source format to a target format and converting the message from the target format to an audible format, <u>Rodriguez et al.</u> cannot disclose or suggest each of the features recited in claim 20.

For at least the foregoing reasons, Applicants submit that claim 20 is not anticipated by <u>Rodriguez et al.</u> Claims 21-29 and 34-36 depend from claim 20 and are, therefore, not anticipated by <u>Rodriguez et al.</u> for at least the reasons given with regard to claim 20.

Amended claim 37 recites a combination of features of a computer-readable medium that stores instructions executable by at least one computer to perform a method for presenting a message to a receiving party. The computer-readable medium includes instructions for obtaining a message intended for the receiving party where the message includes one or more message attachments; instructions for determining whether the one or more message attachments are convertible into a target format; and instructions for generating a description of the one or more message attachments when the one or more message attachments are not convertible into the target format. The computer-readable medium also includes instructions for initiating a telephony call to the receiving party; and instructions for presenting the message with the generated description to the receiving party during the telephony call.

<u>Rodriguez et al.</u> does not disclose or suggest each of the features recited in amended claim 37. For example, <u>Rodriguez et al.</u> does not disclose or suggest determining whether one or more message attachments are convertible into a target format and generating a description of the one or more message attachments when the one or more message attachments are not convertible into the target format. These features are also recited in Applicants' claim 32. The Examiner identified these features as allowable (Office Action, page 13).

For at least the foregoing reasons, Applicants submit that amended claim 37 is allowable and not anticipated by Rodriguez et al. Claims 38-41 depend from claim 37 and are, therefore, allowable and not anticipated by Rodriguez et al. for at least the reasons given with regard to claim 37.

Amended independent claim 42 recites features similar to the features described above with regard to claim 1. Claim 42 is, therefore, not anticipated by Rodriguez et al. for reasons similar to those given with regard to claim 1. Claims 43-47 depend from claim 42 and are, therefore, not anticipated by Rodriguez et al. for at least the reasons given with regard to claim 42.

Amended independent claim 48 recites features similar to the features described above with regard to claim 37. Claim 48 is, therefore, allowable and not anticipated by Rodriguez et al. for reasons similar to those given with regard to claim 37. Claim 49 depends from claim 48 and is, therefore, allowable and not anticipated by Rodriguez et al. for at least the reasons given with regard to claim 48.

At page 13 of the Office Action, the Examiner rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as allegedly unpatentable over Rodriguez et al. in view of McAllister et al. Applicants traverse the rejection.

The McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103. Effective November 29, 1999, subject matter that was prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person (35 U.S.C. § 103(c)). The
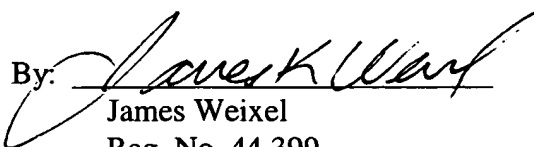
subject matter of the <u>McAllister et al.</u> patent and the claimed invention of the present application were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely Verizon. Therefore, the <u>McAllister et al.</u> patent cannot be used as prior art against this application under 35 U.S.C. § 103.

For at least the foregoing reasons and the reasons given above with regard to claims 1 and 20 (from which claims 12, 13, 30, and 31 depend), Applicants submit that claims 12, 13, 30, and 31 are patentable over <u>Rodriguez et al.</u>

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2339 and please credit any excess fees to such deposit account.

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